

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed August 18, 2008. Claims 1, 3-11, 13-21, 23-31 and 33-40 were pending in the Application. In the Office Action, Claims 1, 3-11, 13-21, 23-31 and 33-40 were rejected. Applicants respectfully request reconsideration and favorable action in this case.

Applicants thank the Examiner for the telephone conference held on October 28, 2008, with Applicants' representative James L. Baudino (Reg. No. 43,486), where a discussion of the rejection under 35 U.S.C. § 112 and the cited references was conducted. No immediate agreement was reached with respect to the claims or purported reference teachings as the Examiner indicated that further review of the cited references would be necessary in view of the arguments presented below.

As an initial matter, in this amendment, Applicants have canceled Claims 11, 13-21, 23-31 and 33-40 without prejudice or disclaimer. Applicants are not conceding that the subject matter encompassed by Claims 11, 13-21, 23-31 and 33-40 is not patentable. Claims 11, 13-21, 23-31 and 33-40 are canceled solely to facilitate expeditious prosecution of the remaining claims. Applicants respectfully reserve the right to pursue claims, including the subject matter encompassed by Claims 11, 13-21, 23-31 and 33-40, as presented prior to this Amendment and additional claims in one or more continuing applications. Applicants have amended the title, abstract and summary portions of the application to coincide with the above.

In the Office Action, the following actions were taken or matters were raised:

SPECIFICATION OBJECTIONS

The Examiner objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. In this regard, the Examiner appears to consider that the amendment made to Claim 1 in the response filed on June 6, 2008, is not supported by the specification as filed because the Examiner asserts that the sender's ability to preclude one that has not yet accessed the e-mail message from accessing the stored e-mail message is not "in response to determining that one of the recipients . . . has accessed the stored e-mail message" (Office Action, pages 4 and 5). Although the Applicants respectfully submit that Claim 1 is supported by the specification such that the sender may preclude one from accessing the e-mail

message in response to the sender determining that one recipient has accessed the e-mail message, in order to advance and expedite prosecution of the instant Application, Applicants have amended Claim 1 to recite, “enabling the sender, if one of the recipients . . . has accessed the stored e-mail message . . . to preclude one of the recipients . . . that have not yet accessed the stored e-mail message from accessing the stored e-mail message.” In the Examiner interview, the Examiner appeared to indicate that the above-referenced amendment to Claim 1 would be acceptable. Therefore, Applicants respectfully request that the specification objection be withdrawn.

SECTION 112 REJECTIONS

Claims 1, 3-6, 11, 13-16, 21, 23-26, 31 and 33-36 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Applicants have canceled without prejudice or disclaimer Claims 11, 13-16, 21, 23-26, 31 and 33-36, thereby rendering the rejection of Claims 11, 13-16, 21, 23-26, 31 and 33-36 moot. Applicants respectfully traverse this rejection for remaining Claims 1 and 3-6.

As indicated above, the Examiner appears to consider that the amendment made to Claim 1 in the response filed on June 6, 2008, is not supported by the specification as filed because the Examiner asserts that the sender’s ability to preclude one that has not yet accessed the e-mail message from accessing the stored e-mail message is not “in response to determining that one of the recipients . . . has accessed the stored e-mail message” (Office Action, pages 4 and 5). Although the Applicants respectfully submit that Claim 1 is supported by the specification such that the sender may preclude one from accessing the e-mail message in response to the sender determining that one recipient has accessed the e-mail message, in order to advance and expedite prosecution of the instant Application, Applicants have amended Claim 1 to recite, “enabling the sender, if one of the recipients . . . has accessed the stored e-mail message . . . to preclude one of the recipients . . . that have not yet accessed the stored e-mail message from accessing the stored e-mail message.” In the Examiner interview, the Examiner appeared to indicate that the above-referenced amendment to Claim 1 would be acceptable. Therefore, Applicants respectfully request that the rejection of Claim 1, and Claims 3-6 that depend therefrom, be withdrawn.

SECTION 103 REJECTIONS

Claims 1, 3, 7-9, 11, 13, 17-19, 21, 23, 27-29, 31, 33 and 37-39 were rejected under 35 U.S.C. §103(a) as being unpatentable over EP Publication No. 1,087,321 issued to Brogne et al. (hereinafter "*Brogne*") in view of U.S. Patent No. 5,930,471 issued to Milewski et al. (hereinafter "*Milewski*"). Claims 4-6, 10, 14-16, 20, 24-26, 30, 34-36 and 40 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Brogne* as applied to Claims 1, 7, 11, 17, 21, 27, 31 and 37 and further in view of what the Examiner considers to be well known in the art. Applicants have canceled without prejudice or disclaimer Claims 11, 13-16, 21, 23-26, 31 and 33-36, thereby rendering the rejection of Claims 11, 13-16, 21, 23-26, 31 and 33-36 moot. Applicants respectfully traverse this rejection for remaining Claims 1, 3-6 and 7-10.

Of the rejected claims, Claims 1 and 7 are independent. Applicants respectfully submit that independent Claims 1 and 7 are patentable over the cited references at least because the cited references, even if combined, fail to teach all features of Claims 1 and 7. For example, Claim 1 recites "determining whether one of the recipients from the list of recipients has accessed the stored e-mail message" and "enabling the sender, if one of the recipients from the list of recipients has accessed the stored e-mail message and using the notification message, to preclude one of the recipients from the list of recipients that have not yet accessed the stored e-mail message from accessing the stored e-mail message" (emphasis added).

In the Office Action, the Examiner appears to rely on *Milewski* for purportedly teaching sending a notification message to the recipients and the sender of the e-mail (Office Action, page 8). The Examiner appears to assert that *Brogne* teaches enabling the sender from precluding a recipient from accessing an e-mail message if one of the other recipients has accessed the e-mail message (Office Action, page 7). In this regard, the Examiner appears to indicate that *Brogne* teaches that the sender can modify a message so long as the message has not yet been accessed by all of the addressees (Office Action, pages 3 and 4). In the Examiner interview, the Examiner also appears to consider deleting the message as a modification of the message. Applicants respectfully disagree with the Examiner regarding the asserted teachings of *Brogne*.

Brogne recites the following regarding the ability of the sender to access the e-mail message:

The condition for the modification to be accepted by the server is that none of its addressees has read the sent e-mail, when the sender wants to manipulate the sent e-mail.

(*Brogne*, abstract) (emphasis added). *Brogne* also recites:

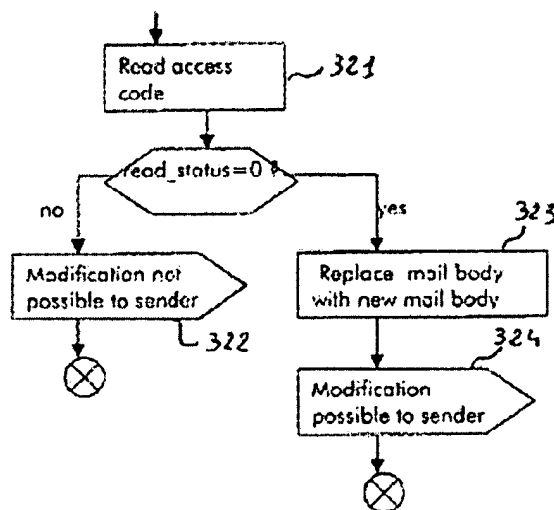
If the server receives a modification message dedicated to modify the stored e-mail body, this modification is executing according to the content of the modification message only if the e-mail body has not been accessed by any of the addressees.

(*Brogne*, paragraph 0010 (column 2, lines 21-25)) (emphasis added). *Brogne* further recites:

A particular object of the present invention is to provide a method of manipulating an already sent e-mail addressed by a sender to an addressee, so that the sender can retract or modify the already sent e-mail as long as the addressee of the e-mail has not accessed it.

(*Brogne*, paragraph 0008 (column 2, lines 1-6) (emphasis added).

Applicants also refer the Examiner to Fig. 3 of *Brogne*, a portion of which is reproduced below, which illustrates a “read_status” decision block. According to Fig. 3 of *Brogne*, if the read status of the e-mail message is null (=0), the “yes” branch of the flow diagram proceeds to block 323 indicating that the mail body of the message is replaced with the new message. However, if the read status is not null ($\neq 0$), the “no” branch of the flow diagram proceeds to block 322 indicating that the sender is not allowed to modify the message. Thus, Fig. 3 of *Brogne* appears to clearly indicate that if even one addressee has read the message, modification of the message is not allowed. Fig. 5 of *Brogne* appears to disclose an identical process regarding the read status of the message.



Thus, *Brogne* appears to clearly indicate that if even one addressee has accessed the message, the sender may not modify or retract the message. In the Office Action, the Examiner appears to refer to paragraph 0035 of *Brogne*. Paragraph 0035 of *Brogne* recites the following:

If the status storage is equal to null, the program executes step 323, if not the program executes step 324 and following.

Step 323: the program sends a message to the sender of the modification e-mail indicating that the modification is not possible and returns to the idle state.

Step 324: the program authorizes the access of the sender 10 to the e-mail body stored in the database so that the sender 10 manipulates the e-mail body and returns to the idle state when the manipulation is completed.

Applicants respectfully submit that the above-referenced portion of *Brogne* appears to contradict Fig. 3 of *Brogne* as well as the remaining teachings of *Brogne*. Thus, Applicants respectfully submit that the above-referenced portion of *Brogne* relied on by the Examiner appears to incorporate a clerical error such that reference to step 323 above should be step 322, and that reference to step 324 above should be 323.

Thus, for at least the reasons indicated above, Applicants respectfully submit that even if combined, the purported teachings of the cited references do not appear to disclose all the features recited by Claim 1.

Independent Claim 7 recites “**determining whether at least one recipient from the list of recipients has already accessed the stored e-mail message,**” “displaying the list of recipients and a copy of the stored e-mail message to the sender wherein all recipients from the list of recipients that are determined to have already accessed the stored e-mail message are displayed in a distinguishing fashion from recipients that have not already accessed the stored e-mail message” and “**allowing the sender to modify the displayed copy of the stored e-mail message and to send the modified copy to the recipients that have not already accessed the stored e-mail message**” (emphasis added). At least for the reasons indicated above in connection with independent Claim 1, Applicants respectfully submit that Claim 7 is also patentable over the cited references. For example, as indicated above, *Brogne* appears to disclose that if even one addressee has accessed the e-mail message, modification or retraction of the message by the sender is not allowed.

Further, *Brogne* appears to clearly teach away from the modification proposed by the Examiner. For example, the Examiner appears to assert that it would have been obvious to combine the purported reference teachings to enable the sender to rescind a previously sent message (Office Action, page 8). However, as indicated above, *Brogne* appears to explicitly teach away from the proposed modification as *Brogne* explicitly indicates that if even one addressee has accessed a message, retraction or modification of the message is not allowed.

Additionally, Claim 7 recites “allowing the sender to modify the displayed copy of the stored e-mail message and to send the modified copy to the recipients that have not already accessed the stored e-mail message” (emphasis added). FIG. 6 of *Milewski* appears to disclose a form 600 indicating the status of the message distributed to the recipients. *Milewski* appears to disclose that the form 600 includes a field 614 for deleting the message (*Milewski*, column 8, lines 22-24, figure 6). Thus, *Milewski* does not appear to enable the sender to access the stored message or to modify the stored message. To the contrary, *Milewski* appears to disclose that the sender may only delete the message. Further, even if deleting the message was considered to be

accessing the stored message, which Applicants respectfully disagree, there would be no message to thereafter send to the recipients that have not already accessed the message. Thus, even if combined, the cited references do not appear to disclose “allowing the sender to modify the displayed copy of the stored e-mail message and to send the modified copy to the recipients that have not already accessed the stored e-mail message” as recited by Claim 7 (emphasis added).

Therefore, Applicants respectfully submit that independent Claims 1 and 7, and Claims 3-6 and 8-10 that depend respectively therefrom, are patentable over the cited references.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

No fee is believed due with this response. If, however, Applicants have overlooked the need for any fee due with this response, the Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this Response to Deposit Account No. 09-0447 of IBM Corporation.

Respectfully submitted,

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